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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,549	03/20/2001	Tomohiro Nagata	001560-392	2540

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EXAMINER

ELISCA, PIERRE E

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 02/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/787,549

Applicant(s)
Tomohiro Nagata et al

Examiner
Pierre E. Elisca

Art Unit
3621



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/01/2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION
RESPONSE TO AMENDMENT

1. This Office action is in response to Applicant's amendment, filed on 12/01/2003.
2. Claims 1-18 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-18 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Collart (U.S. Pat. No. 6,405,203) in view of Fukushima et al. (U.S. Pat. No. 6,185,321).**

As per claims 1, 12-15 and 17 Collart substantially discloses a system/method, and article of manufacture for tracking the distribution of content electronically, comprising:

provided in a product distribution environment where products, in the form of digital content, are distributed through electronic transmission between a product provider comprising at least one of a copyright owner creating a product and a distributor distributing the product, and a product user receiving the product from the product provider, for exchanging copyright information relating to the product through the communications lines with both of the product provider and the product user

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(see., abstract, col 4, lines 28-38, col 6, lines 1-63, specifically distributor, retailer and consumer, figs 1 and 2);

the copyright information management center centrally managing all copyright information existing in the product distribution environment through the electronic transmission by preregistering copyright information relating to the individual products in the center (see., abstract, fig 1, col 40, lines 11-22, specifically wherein it is stated that registered users who accepted the software license agreement).

Collart fails to explicitly disclose Applicant's newly added limitation wherein said product provider information and product information is available for retrieval by the product user at a time beginning prior to receiving the product in a final form (which is readable as pre-registered copy or data prior to receiving the product). However, Fukushima discloses a digital copying machine in which copy-prohibited image has been pre-registered (see., abstract, col 23, lines 32-67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the electronic storage medium of Collart by including the limitation detailed above as taught by Fukushima because this would determine if the copy data as received via the electronic transmission are prohibited to be copied.

As per claims 2, 8, 9, 10, 11, 16 and 18 Collart discloses the claimed limitations of providing with a digital watermark embedding means by which at least one of the copyright owner and the distributor can embed copyright information relating to a product as digital watermark information directly in

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the data forming the product (see., col 31, lines 16-51, specifically wherein it is stated that watermarking enables identification and tracing of different copies of video data, col 33, lines 10-20, specifically watermarking which uniquely identifies each receiver of the signal).

As per claims 3, 4, 5, 6, and 7 Collart discloses the claimed limitations of providing with a digital watermark detection means for detecting the digital watermark information by the product provider and product user see., col 31, lines 16-51, specifically wherein it is stated that watermarking enables identification and tracing of different copies of video data, and detecting means see., col 32, lines 41-61, specifically watermark, if applied to individual copies of the video, may also be used to identify or detecting of the receiver of the copy, fig 5, item 550).

RESPONSE TO ARGUMENTS

5. Applicant's arguments filed 12/01/2003 have been fully considered but they are moot in view of new ground (s) of rejection. Necessitated by amendment.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication from the examiner should be directed to Pierre Eddy Elisca at (703) 305-3987. The examiner can normally be reached on Tuesday to Friday from 6:30AM. to 5:00PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768.


Any response to this action should be mailed to:

Commissioner of patents and Trademarks

Washington, D.C. 20231

The Official Fax Number For TC-3600 is:

(703) 305-7687


Pierre Eddy Elisca

Primary Patent Examiner

January 30, 2004